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10/644,094	08/20/2003	Tomohiro Shinoda	3022-0019	4947

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EXAMINER	
HARPER, TRAMAR YONG	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/644,094	SHINODA, TOMOHIRO	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-5,7-12,14 and 25-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-5,7-12,14 and 25-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/16/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges the receipt of a Request for Continued Examination received 2/16/07. Examiner acknowledges the receipt of the amendment filed 2/16/07. The arguments set forth in the response are addressed herein below. Claims 2-5, 7-12, 14, and 25-43 are pending, Claims 1, 6, 13, and 15-24 have been canceled, and Claims 25-43 are newly added.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-5, 7-12, 14, and 25-43 are rejected on the ground of nonstatutory double patenting over claims 1-19 of U. S. Patent No. 7,001,276 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 2-5, 7-12, 14, and 25-43 are a narrower in scope than the Claims 1-19 of the US Patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3, 5, 7-10, 12, 14, 25-28, 30-31, 33-37, 39-40, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US 6,877,096).

Claims 2-3, 5, 7-10, 12, 14, 25-28, 33-37 & 42-43: Chung discloses a gaming environment wherein a token is introduced to an input device connected to a gaming console enable a range of functionality into a game (Abstract). Chung discloses that either 100, 105 the design of the input device (wherein the token is introduced and are three dimensional) may take the form of the nature of the game and be a control device. For example, for a racing car game the device may take the form of the player's racing car (character or figure) and the tokens may represent different parts of the car, such as

engine, wheels, etc (such qualities are known as character data or bonus data, which is interpreted as data gaining a player further incentives of capabilities). The more tokens the greater the capabilities (Col. 6:30-42). Chung also discloses that each disc may correspond to a different weapon. The more discs that have been introduced, the more weapons a player has access to (interpreted as a bonus incentive/profit). Chung further discloses that each disc may correspond to a different database providing such game initial/conditional data (Col. 5:1-8). As such, this is interpreted as discs/tokens containing game initial data from a plurality of game initial/conditional data. Also in terms of the base portion in which one or more tokens are attachable/detachable from, Chung discloses the devices 100, 105 (which represent two token readable devices (Col. 2:36-37)) contain a top portion 107 and a bottom base portion 110. The one or more tokens may be attached on the upper surface of the base body portion of devices 100, 105 (Col. 2:43-44, 43-54). Chung discloses a 3d integrated circuit disk/token comprising of a RFID a microprocessor (figure 3 processor), a control gate array, storage or memory, and a connector (Col. 3:55-64, Col. 5:48-60, Figs. 1-3). The token includes a stored character data set (Col. 5:1-14). 4:50-60 discloses a stored interactive game.

Chung fails to disclose reading the game initial data of the respective figure when the figure with the token is set on the gaming machine. However, Applicant has not disclosed that reading the game initial data when the figure with the token is set on the gaming machine provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Chung's figure with token linked to the

gaming machine, and applicant's invention, to perform equally well with either the data read when the figure with token linked to the gaming machine, as taught by Chung, or the claimed data read when the figure with token is set on the gaming machine because both would perform the same functions of reading the gaming initial data to the gaming machine.

Therefore, it would have been prima facie obvious to modify Chung such that the game initial data is read when the figure with token is set on the gaming machine because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chung.

Claims 30 & 39: Chung discloses the above limitations with respect to Claims 25 & 35, but excludes the game initial data comprising of an identification code for identifying the token. Chung discloses that the reading device is capable of acquiring identifying indicia stored on or within discs. Chung discloses the use of frequency id's, bar codes, etc. for identifying the various tokens (Col. 3:55-Col. 4:44). However, Applicant has not disclosed providing an identification code within the game data provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Chung's identification means (see above), and applicant's invention, to perform equally well with either the identifying the token via radio frequency id, bar codes, etc, as taught by Chung, or the claimed game initial data including an identification code because both would perform the same functions of identifying a token.

Therefore, it would have been prima facie obvious to modify Chung such that the game initial data includes an identification code because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chung.

Claims 31 & 40: Chung discloses that the more tokens the greater the capabilities (Col. 6:30-42). Chung also discloses that each disc may correspond to a different weapon. The more discs that have been introduced, the more weapons a player has access to (interpreted as a bonus incentive/profit). Chung further discloses that each disc may correspond to a different database providing such game initial/conditional data (Col. 5:1-8). Chung discloses that disc can correspond to some bonus data such a missile launcher that initially contains a predetermined amount of missiles (Col. 6:1-15)(e.g. a data set with a predetermined profit).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US Patent 6,877,096) as applied to the claims above in view of Nakamura (US Patent 6,468,162).

Chung discloses all of the instant application as discussed above but lacks in disclosing selecting initial data sets randomly from a initial data group. Nakamura teaches a character information data set selected from a plurality of items of a character information data group at random and stored on a portable media device for use in an arcade or domestic gaming machine (Col. 6:13-18). Nakamura discloses that the data can be selected and stored based on information not already stored on the portable media device (Col. 2:31-33, interpreted as bonus data or information). It would have

been obvious to one of ordinary skill at the time of the invention to modify the token gaming system, as taught by Chung, with to randomly select character/bonus gaming information, as taught by Nakamura, to provide player enjoyment of purchasing and collecting character/bonus information and enhance a player's hope of getting character information which the player has not possessed (Col. 2:6-20).

Allowable Subject Matter

Claims 29, 32, 38, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 2/16/07 have been fully considered but they are not persuasive. Examiner contends Chung's reading device can take the form of a figure or character correlating to the type of game being played such as a car. Furthermore, each token can represent a different type of condition or variable representative of the car (see above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714

TH

4/12/07